

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1-4 and 6-22 remain pending. Claims 1, 6, and 10 are independent. In this Reply, Applicant has amended claims 1, 6, and 10 to even more clearly establish that there is first a sending of an image and a designation of the destination terminal that is to receive that image after appropriate processing. Support for these changes appears at least at page 17, lines 20-25, of the specification such that no new matter has been introduced.

Prior Art Rejection

Claims 1-4 and 6-22 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over “Spyglass Prism” (Concepts and Applications: Spyglass Prism, 1997) in view of Fox et al. (an article entitled “Reducing WWW Latency and Bandwidth Requirements by Real-Time Distillation”) (hereinafter “Fox”) and further in view of U.S. Patent No. 6,167,441 to Himmel (hereinafter “Himmel”). This rejection, insofar as it pertains the presently pending claims, is respectfully traversed.

Applicant hereby incorporates by reference the arguments traversing the Examiner’s rejection under § 103 based on the asserted combination of Spyglass Prism and Fox from the After-Final Reply dated March 6, 2008 and from the RCE Amendment filed April 8, 2008. In view of the outstanding Action, Applicant has further amended independent claims 1, 6 and 10 in an effort to expedite prosecution of the present application. More specifically, Applicant has amended claim 1 to make it even clearer that the image sending system sends an image received from an image sending terminal to a destination terminal only after receipt of the image from the image sending terminal along with information designating the destination terminal, where the terminal information acquiring means of the image sending terminal then requests the destination terminal designated by the image sending terminal to provide destination terminal information about the destination terminal and then acquires this requested destination terminal information from the destination terminal. Independent claims 6 and 10 have been similarly amended.

Spyglass Prism specifies that “when a user logs on to Spyglass Prism for the first time, they may be asked to enter a series of conversion preferences that are stored in the User Database.” (See the second paragraph of the section titled “Transaction Manager” on page 4).

The outstanding Action suggests that these user conversion preferences obtained at the first user log on are somehow relevant to the claim 1 “terminal information acquiring means.” However, the claim 1 “terminal information acquiring means” is not and was not recited to simply retain information about a terminal that is logging itself into the system for the first time. Instead, it was clear that the information had to be “destination terminal” information that was obtained from this “destination terminal” by making a request for this information to this “destination terminal.”

To emphasize that information obtained from the user at initial log in to the Spyglass Prism is not relevant, claim 1 now clarifies the function of the “terminal information acquiring means” to be “for receiving the image and information designating the destination terminal from an image sending terminal, thereafter requesting the destination terminal designated by the image sending terminal to provide destination terminal information about the destination terminal, and acquiring the requested destination terminal information from the destination terminal.”

Just as information obtained from the user at initial log on to the Spyglass Prism is not relevant to this amended claim 1 subject matter, neither is the relied upon contents of the “Device database” noted at page 3 of the outstanding Action relative to the “Transaction Manager” section at page 4 of the Spyglass disclosure. In this respect, the Spyglass Prism disclosure of the third paragraph of the section titled “Transaction Manager” on page 4 is that “[t]he system administrator enters information into the Device Database through the administration interface.” Clearly, nothing in this system administrator data entry disclosure teaches or suggests the above-noted claim 1 required “receiving the image and information designating the destination terminal from an image sending terminal, thereafter requesting the destination terminal designated by the image sending terminal to provide destination terminal information about the destination terminal, and acquiring the requested destination terminal information from the destination terminal.”

It is by now well established that the first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 [58 USPQ2d 1801, 1806] (Fed. Cir. 2001). It is further well established that the PTO must demonstrate that the references relied upon teach the same

function that is claimed. *See Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997).

As the above-noted limitations of claim 1 are not even remotely suggested by the Spyglass Prism disclosure and neither of the secondary references to Fox or Himmel make up for the above-noted deficiencies of the Spyglass Prism disclosure, Applicant submits that this requested.

As independent claims 6 and 10 have been amended to incorporate subject matter that parallels the subject matter incorporated into claim 1, Applicant submits that this rejection of claims 6 and 10 also cannot be reasonably asserted to be proper and the withdrawal thereof is, therefore, also rejection of claim 1 cannot be reasonably asserted to be proper and the withdrawal thereof is, therefore, respectfully requested.

Furthermore, as claims 2-4 and 11-14 depend directly or indirectly from independent claim 1, claims 7-9 and 15-18 depend directly or indirectly from independent claim 6, and claims 19-22 depend directly or indirectly from independent claim 10, these dependent claims are believed to patentably define over the applied references at least for the same reasons their corresponding parent independent claim does. In addition, all of these dependent claims add further features not taught or suggested by any of the applied references and should be considered to patentably define there over for this reason as well.

Improper Interpretation of MPEP §2144.03 and the Cited Decision

It is noted that the paragraph bridging pages 8 and 9 of the outstanding Action misinterprets MPEP §2144.03 as establishing a legal principle. However, the MPEP does not have the force of law, and is entitled to legal effect only as to representing the PTO interpretation of statutes and regulation. *See Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1180 n.10, 33 USPQ2d 1823, 1828 n.10 (Fed. Cir. 1995). Moreover, this section itself notes the controlling decision of *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697-98 (Fed. Cir. 2001) as establishing that the PTO can never rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based. Nothing in the PTO improper interpretation of *In re Chevenard*, 139 F.2d 71, 60 USPQ 239

(CCPA 1943) can overrule *Zurko* by creating a PTO interpreted rule of admitted prior art. In this last respect the court in *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943) only noted that they would not consider the argument challenging the PTO position as it had not been made before the PTO, not that they considered there to be any admitted prior art because the Applicant did not challenge the assertion at the very first opportunity in the reply to the Action which made the assertion.

Also, nothing in *Chevenard* supports the apparent PTO interpretation that anything more than a demand for evidence is required to put the PTO to its duty of supplying evidence under the applicable law, not mere opinion and unsupported conclusions. See *In re Lee*, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002), as follows:

In finding relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint [that of the person of ordinary skill in the art to which the subject matter pertains]. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administration procedure or effective judicial review.

In accordance with the above noted legal precedent, it is demanded that the PTO carry its burden under the Administrative Procedure Act and produce the substantial evidence required thereby as to the mere conclusions of knowledge in the art offered as to the rejection of claim 1 based on asserted but unproven "programming choice" at page 5, lines 12-13, of the outstanding Action; the rejection of claim 12 based on the mere conclusion offered at page 7 of the outstanding Action as to a cellular network bandwidth being lower than that of an undefined wired network; and assertions as to cellular phones and JPEG made at page 8 of the outstanding Action relative to Claims 13 and 14.

With further regard to the asserted but unproven "simple programming choice" at page 5, lines 12-13, of the outstanding Action, lines 4-7 on this page concede that Spyglass ("Concepts and Applications: Spy Prism") and Fox ("Reducing WW Latency and Bandwidth Requirements by Real-Time Distillation") do not teach the recital of previously presented claim 1 that required "upon receipt of an image from a sender terminal" the terminal information acquiring means would request "the destination terminal to provide destination terminal

information about the destination terminal" and acquire "the destination terminal information from the destination terminal." The thrust of this claimed subject matter was clearly that these were different terminals. The independent claims now expressly state that the image sending terminal is different from the destination terminal.

In an attempt to compensate for this lack of a Spyglass-Fox teaching of this subject matter, page 5, lines 7-10, of the outstanding Action urges that Himmel discloses another image conversion system which sends a request to a destination terminal for capabilities information to be used to convert incoming images. This portion of the outstanding Action also points out that Fig. 6 of Himmel teaches "choosing an image which looks the best" and choosing what type of computer the destination device is. The outstanding Action further concedes that Himmel does not expressly disclose that the query is done in response to receiving an image. However, the outstanding Action alleges that one skilled in the art would easily make this modification as a simple programming choice. Applicant disagrees.

Himmel relates to customizing the selection of Web pages in an Internet environment based on the requesting client device (see column 1, lines 7 to 9). One of the objects of Himmel is to determine the type of client device which is requesting services from a web server (see column 2, lines 20 to 22). A client browser 151 resident at one of the client devices issues an HTTP request 153 for an HTML page at a particular URL. The request is directed to the client-smart agent 155 which first attempts to identify the client using the HTTP header information. If this is unsuccessful, the client-smart agent downloads 157 a client-snooper agent 159 to the client to get the information necessary about the client device to choose an appropriate web page (see column 6, lines 45 to 54). Himmel merely acquires information about the requesting client device. Himmel does not disclose or suggest the feature "acquiring the requested destination terminal information from the destination terminal" that is different from the image sending terminal, such that programming choices, simple or complex would not have led the artisan to the claimed subject matter.

Conclusion

Should there be any outstanding matters that need to be resolved in the present Application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Reg. No. 40,440, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

By 

D. Richard Anderson
Registration No.: 40,439
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant